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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,434	12/19/2001	Yoshiaki Yokoo	159-69	2082

23117 7590 09/21/2005

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EXAMINER

WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/021,434

Applicant(s)

YOKOO ET AL.

Examiner

Anthony Weier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18-24, 27-30 and 33-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-24, 27-30 and 33-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 112**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27 is indefinite in that it calls for sodium bicarbonate outside the range already called for in claim 18 (i.e. the endpoint 0.14% is not included in the range of claim 18).

In claim 54, it is not clear at what point an amount of sweetener is considered to provide a product that is "lightly sweetened".

### **Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-24, 27-30, and 33-37 are rejected under 35 USC 102(b) as being anticipated by Sasagawa et al.

The claims stand rejected for the reasons set forth in the last Office Action.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasagawa et al.

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The claims stand rejected for the reasons set forth in the last Office Action.

5. Claims 38-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-9190 taken together with Kawai et al.

JP 11-9190 discloses a product containing an amino acid added coffee component with a cow milk component added therein and wherein the product has been heat sterilized (see Abstract). It should be further noted that JP 11-9190 discloses said composition having a pH within the range claims (e.g. pH 6.9; see Example 1), the amount of milk called for (e.g. approximately 5% in Example 1), and the amount of amino acid called for (approximately 0.12%; see Example 1; 1.22 g out of a total of 1000 g). It is expected that the amount of sodium bicarbonate added would be less than 0.14 % as it is such a low amount it is not included in the composition breakdown of the product in Example 1 of JP 11-9190. In addition, JP 11-9190 discloses packaging said milk in a hermetically sealed container (e.g. retort can), and it is expected that same would then be capable of marketing.

The claims differ in that JP 11-9190 is silent regarding the use of a basic amino acid (lysine, arginine or histidine). However, it is known to employ arginine, a basic amino acid, in coffee preparations (which also contain a milk component) to improve the flavor of the coffee as taught, for example, by Kawai et al (e.g. Abstract; Examples). It would have been obvious to one having ordinary skill in the art at the time of the invention to have included arginine as the amino acid in JP 11-9190 for the flavor improvement recited in Kawai et al.

It is expected that the addition the basic amino acid in the modified JP 11-9190 product would reduce the amount of emulsifier and/or thickening agent required. In addition, JP 11-9190 discloses the use of an emulsifier in the composition which occupies well below 1% of the product (0.3 g sucrose fatty acid ester in a 52 g coffee extract composition which further includes milk and other ingredients; see translation).

Although Example 1 of JP 11-9190 discloses the use of approximately 12% milk, JP 11-9190 does not limit the milk to any particular amount. It would have been well within the purview of one skilled in the art to determined such amount, and it would have been obvious to have arrived at such amount as a result effective variable depending on, for example, the degree of dairy flavor desired in the final product.

JP 11-9190 further discloses said composition being lightly sweetened (e.g. 0.06% cane sugar).

### **Response to Arguments**

6. Applicant's arguments filed 9/6/05 have been fully considered but they are not persuasive.

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Applicants argue that Sasagawa et al does not suggest the use of a strongly basic substance (other than phosphate salts) that prevent precipitates from being formed in milk-added coffee beverage during or after heat treatment. It should be noted that the drinks being treated in Sasagawa et al address the issue of using sodium salts to avoid precipitates but to do so in a way that does not result in a product having a poor taste/slimy feel. Sasagawa et al solves this problem by adding potassium hydroxide or other potassium salts to achieve this (col. 2, lines 13-26) wherein same may be used alone or in conjunction with a sodium salt (col. 2, line 26) and in such manner that the pH is above the range that will create precipitates. Nevertheless, although Sasagawa et al prefers using phosphate salts alone or in combination with potassium compounds, same is not required. In fact, Sasagawa et al discloses the use of, for example, potassium hydroxide taken alone (see col. 3, line 33) which reads on the instant claims that call for the presence of a strong basic substance other than a phosphate salt.

Applicants further argue that Sasagawa et al does not address the problem of precipitation. Sasagawa et al does refer to the problem of precipitation in regard to the use of sodium bicarbonate. However, the rest of the patent appears to be silent regarding the issue. Nevertheless, it is considered expected that the invention as set forth and relied upon in Sasagawa et al would also provide the reduction in precipitation due to the similarity in processing with the instant invention.

### Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action in view of the significantly altered claim language, particularly newly recited limitations regarding the packaging arrangement and order of opening same. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier  
Primary Examiner  
Art Unit 1761

Anthony Weier  
September 18, 2005

  
9/18/05